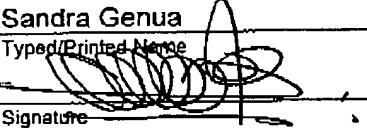


SEP 28 2006



Western Digital Corporation
20511 Lake Forest Drive, E118-G
Lake Forest, California 92630

Tel: 949.672.7000
Fax: 949.672.6604

TO: COMMISSIONER FOR PATENTS, U.S. PATENT & TRADEMARK OFFICE		
FAX NO: (571) 273-8300 (GENERAL/MAIN FAX LINE)		
NO. OF PAGES: Cover + 6		
CERTIFICATE OF FACSIMILE TRANSMISSION I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below. Sandra Genua Typed/Printed Name  Signature September 28, 2006 Date	APPLICATION NO.	
	10/698,713	
	FILING DATE	
	October 31, 2003	
	FIRST NAMED INVENTOR	
	Yih-Jen Dennis Chen	
	ART UNIT	
2627		
CONFIRMATION NO.	1559	
EXAMINER	Davis, David D.	
ATTORNEY DOCKET NO.	A1314	
TITLE	METHOD OF ASSEMBLING A DISK DRIVE INCLUDING ACTUATING A SHIPPING COMB TO BEND A SUSPENSION VERTICALLY TO FACILITATE A MERGE TOOL (AS AMENDED)	

ATTACHED WITH THIS SUBMISSION:

1. Notice of Appeal (1 page)
2. Pre-Appeal Brief Request for Review, PTO/SB/33 (5 pages)

PLEASE CONFIRM RECEIPT OF THIS TRANSMISSION. IF THERE IS ANY PROBLEM WITH THIS TRANSMISSION, PLEASE CALL SANDRA GENUA AT (949) 672-7780.

CONFIDENTIALITY NOTE

THE INFORMATION CONTAINED IN THIS FACSIMILE TRANSMISSION MAY BE LEGALLY PRIVILEGED AND IS CONFIDENTIAL INFORMATION INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY NAMED ABOVE. IT IS EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW, INCLUDING COURT ORDERS, IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THIS FACSIMILE TRANSMISSION TO THE INTENDED RECIPIENT. YOU ARE HEREBY NOTIFIED THAT ANY USE, DISSEMINATION, DISTRIBUTION OR COPY OF THIS FACSIMILE TRANSMISSION OR ITS INFORMATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS FACSIMILE TRANSMISSION IN ERROR, PLEASE IMMEDIATELY NOTIFY US BY TELEFAX OR TELEPHONE USING THE ABOVE NUMBERS AND AIRMAIL THIS FACSIMILE TRANSMISSION BACK TO US IMMEDIATELY. THANK YOU.

Y:\IP PROGRAM_K35A\FILES\A1300-A1399\A1314\PTOA\A1314_Faxcover USPTO_092806.doc

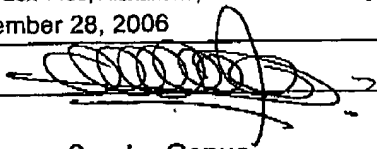
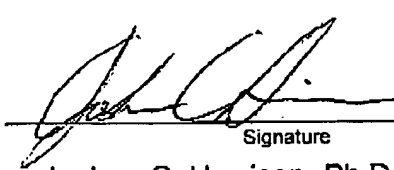
SEP 28 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0851-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) A1314	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 28, 2006</u> Signature  Typed or printed name <u>Sandra Genua</u>		Application Number <u>10/698,713</u>	Filed <u>10/31/2003</u>
		First Named Inventor <u>Chen et al.</u>	
		Art Unit <u>2627</u>	Examiner <u>Davis, David Donald</u>
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>45,686</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature <u>Joshua C. Harrison, Ph.D., Esq.</u> Typed or printed name <u>(949) 672-6119</u> Telephone number <u>September 28, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Pre-Appeal Brief Request for Review
U.S. Serial Number: 10/698,713

SEP 28 2006

PATENT

Attorney Docket: K35A1314 (PA3898US)

REASONS FOR REVIEW

Claims 11-15 are pending in the application and have been rejected under 35 U.S.C. §102(b) as being anticipated by Perry (US 4,851,943). Claim 15 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Perry. The method of independent claim 11 is directed to manufacturing a disk drive comprising a head stack assembly (HSA) that itself comprises a suspension and a shipping comb. The method comprises "actuating the shipping comb to bend the suspension in a vertical direction to facilitate the insertion of a merge tool comprising a finger for engaging the suspension." Applicants assert that Perry cannot anticipate claim 11 because Perry does not teach both a shipping comb and a merge tool.

Applicants note MPEP §2111 which provides that "[d]uring patent examination, the pending claims must be 'given their broadest *reasonable* interpretation consistent with the specification.' *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000, emphasis added)." In view of the requirement that claim 11 must be given an interpretation that is no broader than is reasonable in light of the specification, Applicants contend that the interpretations given by the Examiner to "shipping comb" and "merge tool" are unreasonably broad in view of the specification. Applicants assert that in view of the specification, taken as a whole, one of ordinary skill in the art would understand that the shipping comb and the merge tool recited in claim 11 are distinct components from one another, as previously noted on page 9 of the Response to Office Action mailed on December 22, 2005. This would be understood, for example, because the "shipping comb is attached to protect the suspension 16 during storage and shipping" (page 1 lines 21-22), while the merge tool is employed during disk drive manufacturing to facilitate installation of the HSA 6 (page 2 lines 6-7). Applicants also note that Price et al. (US 5,826,325) and Frater et al. (US 6,069,773), both cited in an IDS submitted with the application, support the assertion that merge tools were known in the art and that, by extension, one of ordinary skill would understand that the shipping comb disclosed by the present application is a component that is distinct from the merge tool.

Based on the teleconference of August 9, 2006, it is Applicants' understanding that the Examiner views loader 100 of Perry as reading on both the shipping comb and

Pre-Appeal Brief Request for Review
U.S. Serial Number: 10/698,713

PATENT
Attorney Docket: K35A1314 (PA3898US)

the merge tool of claim 11. Based on the teleconference, it is Applicants' understanding that the Examiner views the guide piece 114, comprising a plurality of guides 120 (see FIG. 2), as reading on the shipping comb, and views the blades 125 as reading on the merge tool. However, the guide piece 114 and the blades 125 are parts of the same loader 100, and therefore not distinct from one another. Reading the loader 100 of Perry on both the shipping comb and the merge tool of claim 11 is therefore giving "shipping comb" and "merge tool" unreasonably broad interpretations in view of the specification, which consistently refers to them as distinct entities and calls them out separately in the claims.

However, even if, *arguendo*, one accepts the Examiner's position, Perry does not read on claim 11. Claim 11 requires "actuating the shipping comb to bend the suspension in a vertical direction." FIGs. 4-10 of Perry show the loader 100 at sequential stages of merging the magnetic heads 20 with the magnetic disks 16. With reference to FIGs. 6 and 7 Perry states that "guides 120 are now positioned such that their ends 200 extend between flexible arms 22," and that "[a]t this point, it will be appreciated that loader 100 is simply being mechanically positioned on actuator arm 25, and that the position of magnetic heads 20 has not been affected." (col. 5 lines 53-58). It will be understood, therefore, that at least at this point in the merge process the guides 120 have not bent the flexible arms 22.

Thereafter, with respect to FIGs. 8-10 of Perry, "the final movement of the loader 100 in order to spread magnetic heads 20 is disclosed." (col. 5 lines 61-63) Here, "[t]he extension of blades 125 results in the blades passing out of guide 120 into physical contact with the flexible arms 22." (col. 6 lines 8-11) Applicants assert that this is the only contact shown in Perry between any part of the loader 100 and the flexible arms 22. It should be clear, therefore, that the portion of the loader 100 viewed by the Examiner as the shipping comb of claim 11 (i.e., the guide piece 114 with the guides 120) never bends the suspension as required.

Additionally, claim 11 requires "inserting the merge tool such that the finger of the merge tool moves into position without scraping against the suspension." Accepting that the blades 125 read on the merge tool of claim 11, it should be clear from the above that when the blades 125 make physical contact with the flexible arms 22, as can best be

Pre-Appeal Brief Request for Review
U.S. Serial Number: 10/698,713

PATENT
Attorney Docket: K35A1314 (PA3898US)

seen by FIG. 10, it is inherent that the blades scrape along the undersides of the flexible arms 22 as the flexible arms 22 are pushed into their new positions. In order to not scrape along the undersides of the flexible arms 22, each blade 125 would have to make contact at a fixed point on the underside of the flexible arm 22 and never deviate from that point throughout the pushing process. Clearly, contact at a fixed point cannot be maintained between the blades 125 and the undersides of the flexible arms 22.

Further still, claim 11 requires "detaching the shipping comb from the actuator arm wherein the suspension retracts vertically and engages the finger of the merge tool." As the guides 120 never make contact with the flexible arms 22, the guides 120 cannot be detached from the flexible arms 22. Certainly, withdrawing the guides 120 does not cause the flexible arms 22 to engage fingers of the blades 125 as the blades 125 engage the flexible arms 22 while the guides 120 are held in a fixed position by engagement of a guide pin 110 with a notch 195 (col. 5 lines 48-51).

Regardless of how one tries to parse the loader 100 disclosed by Perry, presently pending claim 11 requires both the merge tool and the shipping comb to come into contact with the suspension, but the loader 100 disclosed by Perry only makes one contact with the flexible arms 22. Specifically, actuating the shipping comb in step (b) bends the suspension, which requires contact between the shipping comb and the suspension as illustrated in FIGs. 6A and 6B, and step (d) further requires contact between the merge tool and the suspension. Yet it has been shown that the only contact between the loader 100 and the flexible arms 22 of Perry is shown in FIG. 10 where the blades 125 engage flexible arms 22. Even if one were to argue that the entirety of the loader 100 simultaneously reads on both the shipping comb and the merge tool, it would be impossible for Perry to meet step (d) which requires "detaching the shipping comb from the actuator arm wherein the suspension retracts vertically and engages the finger of the merge tool." Applicants assert that detaching the loader 100 from actuator arm 25 in Perry cannot cause the flexible arms 22 to engage any portion of the loader 100.

For at least the reasons provided above, Perry cannot anticipate the method of claim 11. Applicants therefore request that the Examiner withdraw the rejections of claim 11, and claims 12-15 depending therefrom, under 35 U.S.C. §102(b).

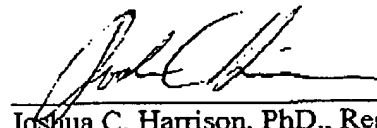
SEP 28 2006

Pre-Appeal Brief Request for Review
U.S. Serial Number: 10/698,713PATENT
Attorney Docket: K35A1314 (PA3898US)

Furthermore, the Examiner has not stated the basis of the rejection of at least claim 11 with sufficient clarity. "A rejection violates 35 U.S.C. §132 if it "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection," (*Chester v. Miller*, 906 F.2d 1574, 1578, 15 USPQ2d 1333, 1337 (Fed Cir. 1990)). Applicants note that in the Final Office Action, for example, the Examiner repeatedly refers to "the finger 120 & 125" as if these reference numerals pertain to the same structure whereas the discussion above shows that reference numeral 120 pertains to a guide while reference numeral 125 refers to a blade that passes through the guide 120. With respect to the steps (a) – (e) of claim 11, Applicants find no mention in the Final Office Action of the steps of "(a) inserting the HSA into the base casting," "(c) inserting the merge tool such that the finger of the merge tool moves into position without scraping against the suspension," or "(d) detaching the shipping comb from the actuator arm wherein the suspension retracts vertically and engages the finger of the merge tool."

Applicants respectfully request that the Panel recognize that Perry does not teach each and every limitation of claim 11, and therefore allow claim 11 and claims 12-15 depending therefrom. Should the Panel have questions, the Applicants' undersigned agent may be reached at the number provided.

Respectfully submitted,

Date: 28SEP06
Joshua C. Harrison, PhD., Reg. No. 26119
WESTERN DIGITAL TECHNOLOGIES, INC.
20511 Lake Forest Drive
Lake Forest, CA 92630
Phone (949) 672-7000
Fax (949) 672-6604